REMARKS

Claims 1 and 32–47 are pending in the present application.

Claims 46–47 were previously withdrawn, but have not been canceled.

Claims 1, 38 and 46 were amended herein.

Reconsideration of the claims is respectfully requested.

Request for Reconsideration of Restriction Requirement

Claims 1 and 32–45 and 46–47 were subject to a restriction requirement. Applicant maintains traversal of the restriction requirement. The failure of the previous response to distinctly and specifically point out the errors in the restriction requirement was inadvertent, and the response was a bona fide attempt to advance prosecution of the application despite such oversight. Applicant was not previously provided with notice and an opportunity to cure such defect in the previous reply. See MPEP § 714.03. Accordingly, the election cannot be properly considered an election without traverse. In addition, Applicant respectfully requests reconsideration of that requirement.

Restriction is only proper where the claims are independent or distinct. MPEP § 806. In passing on questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01. In the present application, claims 1 and 32–45 and claims 46–47 are asserted to be related as a process of making and product made. Paper No. 9, page 2. However, claims 1 and 32–45 and claims 46–47 are ALL product claims, with claims

1 and 32–45 being directed to a final structure and claims 46–47 being directed to an intermediate structure. None of the claims are process claims.

With respect to the assertion that structure of the claims of Group II (the intermediate structure recited in claims 46–47) could be made by a materially different process than that recited in the claims of Group I (claims 1 and 32–45) since the isolation oxide could be formed in two discrete steps rather than one, the claims of Group II do not recite an isolation oxide. Accordingly, formation of the isolation oxide is irrelevant since that feature is not part of the invention as claimed.

Withdrawal of the restriction is respectfully requested.

35 U.S.C. § 102 (Anticipation)

Claims 1, 32–33, 35, 38–40, 42 and 45 were rejected under 35 U.S.C. § 102(e) as being anticipated by EP 0 123 384 to *Harper*. This rejection is respectfully traversed.

A claim is anticipated only if each and every element is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. MPEP § 2131 at p. 2100-69 (8th ed. August 2001).

Independent claims 1 and 38 each recite that the second patterned layer is formed over the first isolation regions (those in the n-type well or the well having the first conductivity type) without growing an oxide over such isolation regions. Such a feature is not found in the cited reference. *Harper* depicts and describes growing a composite oxide 37 over isolation regions within the p-well 22 prior to formation of the p-field mask 40, to tolerate misalignment of the p-field mask 40.

Harper, Figures 6–7, page 17, line 26 through page 18, line 19. In the claimed invention, no isolation oxide is formed except in a single oxidation step following implant of the channel stops in both the n- and p-wells.

Applicant respectfully notes that formation of an isolation oxide in a single step has been asserted by the Patent Office to be "materially different" than (i.e., patentable over) formation of such an isolation oxide in two discrete steps. Paper No. 9, page 2.

Similarly, claim 46 recites that the patterned masking layer on the active stack is directly on the substrate within the isolation regions within the first well. Such a feature is not found in the cited reference.

Therefore, the rejection of claims 1, 32–33, 35, 38–40, 42 and 45 under 35 U.S.C. § 102 has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 34 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Harper* in view of JP 63-271956 to *Hosaka*. Claims 36–37 and 43–44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Harper* in view of *Wolf*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-123 (8th ed. rev. 1 February

2003). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant 's disclosure. MPEP § 2142 at p. 2100-124.

As noted above, the pending independent claims each recite at least one feature not found in *Harper*. Such feature(s) are also not found in *Hosaka* or *Wolf*, taken alone or in combination with *Harper*.

Therefore, the rejection of claim 31, 36–37, 41 and 43–44 under 35 U.S.C. § 103 has been overcome.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***dvenglarik@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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